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EXAMINER

PEAVEY, ENOCH E

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 15

Application Number: 09/381,771  
Filing Date: October 26, 1999  
Appellant(s): THOMSEN, ERIK BROGAARD

**MAILED**

MAR 11 2003

**GROUP 3600**

\_\_\_\_\_  
Ronald Brown  
For Appellant

### **EXAMINER'S ANSWER**

This is in response to the appeal brief filed December 16, 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 9-17 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,941,002

RUSIN

8-1999

Fontworks, Sanity Font Family, Dan Redding & Blue Knot Software copywritten 1997

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 9-17 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The claimed invention relates only to the printed subject matter and does not provide any concrete utility to the invention, the invention simply constitutes an abstract idea, text on a surface and as such does not present subject matter for which a utility patent may be obtained. See State St. Bank & Trust Co. v. Signature Fin. Group, 149 F.3d 1368 (Fed. Cir. 1998).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Fontorks, Sanity Font © 1997 Dan Redding & Blue Knot Software (Fontworks). Fontworks discloses an advertisement print (Sanity Font Family) being printed on a plane print carrier (the page) in which print is plane and lies in the same plane as the print carrier (page 2). The print comprises a primary figurative element (in the x-y plane of the page) depicting an advertisement in a first dimension (x) and a second dimension (y). The primary figurative element (in the x-y plane) when seen in a direction perpendicular to the plane of the print carrier constitutes an angle  $\alpha + 90$  degrees between the first dimension (x) and second dimension (y). The primary figurative element (in the x-y plane) when seen in a given oblique direction between a viewer and the print shows the first dimension (x) and the second dimension (y) as forming a plane of advertisement. The plane of advertisement is directed obliquely outwards of the plane of the print carrier (page 2, Sanity font). The advertisement print comprises a secondary figurative element (shadow relieved into the background) depicting the advertisement in a third dimension (z). The secondary element (shadow relieved into the background) when seen in a direction perpendicular to the plane print carrier

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constitutes an angle  $\alpha + \beta$  between the first dimension (x) and third dimension (z) and which secondary figurative element (shadow relieved into the background) when seen in the given oblique direction between the viewer and the print shows the third dimension as directed perpendicular to the plane of advertisement being formed by the first (x) and second dimension (y) and that the angles  $\alpha$  and  $\beta$  are different from 0 degrees. The print is made of curable ink cured on the plane print carrier (the dried print on the page). The print is made by printing on a carrier medium (the page).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontworks in view of Rusin, US No. 5,941,002. Fontworks discloses the claimed invention except for the print carrier being a ground surface (extending in the vertical direction). Rusin discloses a ground surface print carrier (i.e. the print carrier is located on the ground for displaying advertisement at a sporting event. It would have been obvious to one of ordinary skill in the art at the time of appellants invention to modify Fontworks with the ground surface print carrier of Rusin in order to display the advertisement at a sporting event.

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**(11) *Response to Argument***

With regard to the 35 U.S.C. 101 rejection, appellant argues that the pending claims do not recite unpatentable printed subject matter. The examiner disagrees.

The Supreme Court has identified 3 categories of subject matter that are unpatentable, namely "laws of nature, natural phenomena, and abstract ideas."

State St. Bank & Trust Co. v. Signature Fin. Group, 47 USPQ2d 1600 (CA FC 1998).

Printed subject matter is an abstract idea.

Here the invention is directed towards printed subject matter. Appellant simply claims a print being composed of three figurative elements (the lines forming the letters) extending in the x, y, and z directions. The angular relationships among the figurative elements, when seen from a particular angle, give the print an "appearance" that it is directed off of a surface. Appellant is not concerned with the substrate that the text is printed upon, but the appearance of that text on that substrate. In State Street, the Supreme Court held that printed subject matter is not patentable subject matter. Therefore, subject matter here is not patentable subject matter.

The printed matter merely has a particular appearance and does not provide any useful function. It is the angular relationships among the figurative elements not the substrate that gives the print its appearance. Where printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. In re Gulak, 217 USPQ 401 (CA FC 1983). In In re Miller, there was a functional relationship found between the printed subject matter and

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the substrate. In re Miller, 164 USPQ 49 (CCPA 1969). Here there is no functional relationship. All that exist is the appearance of the printed matter.

In conclusion there is no functional difference, that is to say no new of non-obvious functional relationship exists between the printed matter and the substrate. It is only the human mind that behaves differently when viewing the printed matter.

Therefore, the subject matter is not patentable under 35 U.S.C. 101.

With regard to the 35 U.S.C. 103(a) rejection, Appellant argues that the figurative element disclosed in the Fontworks reference shows the first dimension and the second dimension as forming a plane of advertising that is directed obliquely outward of the plane of the print carrier. The examiner disagrees. It is the shadow of the Fontworks reference in combination with the first and second dimension (x-y plane) that gives the print the appearance that it is directed obliquely outward of the plane. If one was to remove the shadow from the Fontworks reference all that would be left is simple lettering coinciding with the x-y plane. The lettering in Fontwork has the same basic construction as the lettering contained in the instant application (*i.e. the primary figurative element (in the x-y plane) when seen in a given oblique direction between a viewer and the print shows the first dimension (x) and the second dimension (y) as forming a plane of advertisement. The advertisement print comprises a secondary figurative element (shadow relieved into the background) depicting the advertisement in a third dimension (z). The secondary element (shadow relieved into the background) when seen in a direction perpendicular to the plane print carrier constitutes an angle*



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*alpha + beta between the first dimension (x) and third dimension (z) and which secondary figurative element (shadow relieved into the background) when seen in the given oblique direction between the viewer and the print shows the third dimension as directed perpendicular to the plane of advertisement being formed by the first (x) and second dimension (y) and that the angles alpha and beta are different from 0 degrees).*

Because the lettering has the same construction with regard to the angles between the primary, secondary and tertiary figurative elements, they will have the same effect as the advertisement of the instant application, the appellant has failed to point out any language in the claim that would make the Fontworks reference and the reference of the instant application structurally different.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Anthony Knight  
Supervisory Patent Examiner  
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Enoch Peavey  
March 9, 2003

Conferees

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